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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/781,198   | 02/13/2001  | Frank D. Lortscher   | 05793.3027-00       | 8783             |
| 22852  | 7590        | 05/14/2004           | EXAMINER            |                  |
| FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER<br>LLP<br>1300 I STREET, NW<br>WASHINGTON, DC 20005 |             |                      | BORISOV, IGOR N     |                  |
|  |             | ART UNIT             | PAPER NUMBER        |                  |
|  |             |                      | 3629                |                  |

DATE MAILED: 05/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|   |                           |  |  |
|---|---------------------------|--|--|
| <b>Office Action Summary</b>  | Application No.           | Applicant(s)   |  |
|   | 09/781,198                | LORTSCHER ET AL.   |  |
|   | Examiner<br>Igor Borissov | Art Unit<br>3629   |  |
| <i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i><br><b>Period for Reply</b>   |                           |  |  |
| <b>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>03</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.</b>  |                           |  |  |
| <ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul> |                           |  |  |
| <b>Status</b>   |                           |  |  |
| 1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>18 February 2004</u> .<br>2a) <input checked="" type="checkbox"/> This action is <b>FINAL</b> .                    2b) <input type="checkbox"/> This action is non-final.<br>3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.  |                           |  |  |
| <b>Disposition of Claims</b>  |                           |  |  |
| 4) <input checked="" type="checkbox"/> Claim(s) <u>1-40 and 42-118</u> is/are pending in the application.<br>4a) Of the above claim(s) _____ is/are withdrawn from consideration.<br>5) <input type="checkbox"/> Claim(s) _____ is/are allowed.<br>6) <input checked="" type="checkbox"/> Claim(s) <u>1-40 and 42-118</u> is/are rejected.<br>7) <input type="checkbox"/> Claim(s) _____ is/are objected to.<br>8) <input type="checkbox"/> Claim(s) _____ are subject to restriction and/or election requirement.  |                           |  |  |
| <b>Application Papers</b>   |                           |  |  |
| 9) <input type="checkbox"/> The specification is objected to by the Examiner.<br>10) <input type="checkbox"/> The drawing(s) filed on _____ is/are: a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner.<br>Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).<br>Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).<br>11) <input type="checkbox"/> The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.  |                           |  |  |
| <b>Priority under 35 U.S.C. § 119</b>   |                           |  |  |
| 12) <input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).<br>a) <input type="checkbox"/> All    b) <input type="checkbox"/> Some * c) <input type="checkbox"/> None of:<br>1. <input type="checkbox"/> Certified copies of the priority documents have been received.<br>2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.<br>3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).<br>* See the attached detailed Office action for a list of the certified copies not received.   |                           |  |  |
| <b>Attachment(s)</b>  |                           |  |  |
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)<br>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)<br>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____.  |                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____.<br>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)<br>6) <input type="checkbox"/> Other: _____. |  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 14-22, 48-50, 65-72, 89-91, 42-43, 96, 99-113 and 115 are rejected under 35 U.S.C. 101** because the claimed method for sharing consumer information does not recite a limitation in the technological arts. The independently claimed steps of: *offering an incentive to potential users; receiving access preferences from users; creating a database of consumer information; establishing access by subscribers to the consumer information; and setting a licensing fee schedule*, are abstract ideas which can be performed mentally without interaction of a physical structure. The method step: *creating a database of consumer information* may be understood as merely keeping notes about community members in a copybook. However, the claimed invention must utilize technology in a non-trivial manner (*Ex parte Bowman*, 61 USPQ2d 1665, 1671 (*Bd. Pat. App. & Inter. 2001*)).

Because the independently claimed invention is directed to an abstract idea which does not recite a limitation in the technological arts, those claims and claims depending from them, are not permitted under 35 USC 101 as being related to non-statutory subject matter. However, in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-40 and 42-118 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neil et al. (US 5,987,440) in view of Goldhaber et al. (US 5,855,008).**

O'Neil (hereinafter O'Neil) teaches a system and method for personal information security and exchange tool, comprising:

**As per claims 1, 14, 23, 32, 42-44, 89, 92 and 95-98,**

Charging by an individual for accessing to his/her personal consumer information (C. 23, L. 21-23); receiving access preferences information from the individual, said information including rules determining who gets access to each item of information (C. 2, L. 34-35; C. 10, L. 65 – C. 11, L. 1-9); creating a database of said consumer information, establishing access by subscribers to the consumer information (C. 2, L. 34-35); establishing a fee schedule based on said rules for paying each individual based on said fee schedule (C. 10, L. 65 – C. 11, L. 1-9);

O'Neil do not specifically teach that charging by an individual for accessing to his/her personal consumer information includes offering an incentive to said individual for providing his/her personal consumer information.

Goldhaber et al. (hereinafter Goldhaber) teaches a system and method for delivering positively and negatively priced information, including offering to customers an incentive in exchange for providing customer personal information (C. 12, L. 49-61).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify O'Neil to include that said users are consumers which provide their information to merchandisers in response to incentives offered to said consumers, because it would make customers willing to release their personnel information to merchandisers (*subscribers*), which in turn allow said merchandisers to create more effective targeted advertising, thereby increase revenue.

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Also, as per **claim 42**, providing payment to the customers in exchange to interaction with the merchandiser's advertising (C. 10, L. 48-51) obviously indicates paying the customer for purchasing a merchandiser's product.

**As per claims 2, 5, 9-13, 16, 25, 34 and 38-40**, O'Neil teaches said system and method, wherein the licensing agent determines the amount of payment to be made to each user (C. 2, L. 56-63; C. 10, L 61 – C. 11, L 9).

**As per claims 3, 17, 26 and 35**, O'Neil teaches said system and method, further comprising at least one payment agent for paying each user based on a set of payment rules the determined amount of payment (C. 2, L. 56-63; C. 23, L. 20-25).

**As per claims 4**, Goldhaber teaches electronic payment (C. 10, L. 60-68).

**As per claims 6, 18, 27, 36, 104 and 114-118**, O'Neil teaches said system and method wherein the licensing rules include paying the individual a fixed amount received by the system (C. 21, L. 37-62) obviously indicates receiving a fixed percentage of all amounts received by an operator of the system from licensing the personal information related to that user.

**As per claims 7, 15, 24 and 33**, O'Neil teaches said system and method wherein the database containing personal information includes financial information, demographic information, psychometric information, or marketing information (Fig. 30; C. 10, L. 17-60; C. 17, L 1-12).

**As per claims 8, 19, 28, 37, 107, 110 and 113**, O'Neil teaches said system and method wherein the database containing personal information includes information concerning a user of the system from a third-party source of information (C. 2, L. 49-55; C. 6, lines 7-23).

**As per claims 20-22, 29-31, 64, 72, 80, 88 and 99-101**, O'Neil teaches said system and method including establishing said rules (determining schedule fee). The *declining or increasing* fee charging mechanism is well known in the art, and without indication in the specification of the advantage of *declining or increasing* fee schedule over the prior art, it appears that the type of fee schedule (*declining or increasing*) is a matter of business choice.

**As per claims 45-53 and 54-56,** Goldhaber teaches said system and method, wherein the incentive is a product provided at discounted price (C. 10, L. 53 – C. 11, L 15).

**As per claims 58-63, 66-71, 74-79 and 82-87,** Goldhaber teaches said system and method, comprising: creating an account for the potential users, wherein a potential users' response includes user preferences for access to the users' personal information (C. 6, L. 66 – C. 7, L. 11; C. 12, L. 49-61).

**As per claims 57, 65, 73 and 81,** Goldhaber teaches said system and method, comprising: determining a type of incentive to offer to each potential user (C. 10, L. 53 – C. 11, L 15).

**As per claim 90-91 and 93-94, see claim 14.**

**As per claim 102-103, see claim 14.**

**As per claim 105-106, 108-109 and 111-112, see claim 14.**

### ***Response to Arguments***

Applicant's arguments filed 2/18/04 have been fully considered but they are not persuasive.

In response to applicant's argument that **claim 42** does not require that the consumer information be provided in response to an incentive offered to a user, examiner points out that **claim 42** recites method steps of **claim 14**: *creating a database of consumer information; receiving access preferences from each user who contributed consumer information including rules of access to said consumer information.* Therefor, the prior art sited against **claim 14** was also applied to **claim 42**.

In response to applicant's argument that the prior art does not teach a *declining or increasing* fee schedule, examiner maintains, that O'Neil teaches establishing rules to access the individual information including charging fees for the release of said information (C. 21, L. 54). The declining or increasing fee charging mechanism is well

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known in the art (See, for example, US patent 6,236,971 to Stefik et al. C. 23, L. 39-51), and without indication in the specification of the advantage of *declining or increasing* fee schedule over the prior art, it appears that the type of fee schedule is a matter of business choice.

In response to applicant's argument that the prior art does not teach a fee schedule based on the funds received from subscribers, examiner maintains, that O'Neil teaches establishing rules to access the individual information including charging fees for the release of said information (C. 21, L. 54). The usage based (*funds received*) fee charging mechanism is well known in the art (For example, cell-phone payment plans), and without indication in the specification of the advantage of *usage based* fee schedule over the prior art, it appears that the type of fee schedule is a matter of business choice.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, both O'Neil and Goldhaber relate to a method and system for providing personnel consumer information in exchange for a consideration. O'Neil teaches charging by an individual for accessing to his/her personal consumer information (C. 23, L. 21-23). Goldhaber teaches offering to customers an incentive in exchange for providing customer personal information (C. 12, L. 49-61). The motivation to combine these two references would be stimulating customers to release their personnel information to merchandisers, which in turn allow said merchandisers to create more effective targeted advertising, thereby increase revenue.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

***Washington D.C. 20231***

or faxed to:

(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

JOHN G. WEISS  
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TECHNOLOGY CENTER 3600